

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARY L. BATES,  
JERRY A. BLADES, PAUL R. DAY,  
HARVEY G. KIEL, and JEFFREY M. RYAN

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Appeal No. 96-3059  
Application 08/170,569<sup>1</sup>

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ON BRIEF

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Before MARTIN, JERRY SMITH, and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134  
from the examiner's rejection of claims 1-17 which constitute

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<sup>1</sup> Application for patent filed December 20, 1993.

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all the

claims in the application. An amendment after final rejection was filed on July 10, 1995 but was denied entry by the examiner.

The disclosed invention pertains to a method and apparatus for use in a multi-media collaborative data processing system which includes a shared data collection which is simultaneously accessible by a plurality of users located at a plurality of terminals. Specifically, the invention informs the users at each terminal of other users who are actively engaged in a specific application and the location of the other users within the application. The location information is indicated by visual cues which are displayed along a line parallel to the edge of an application display window.

Representative claim 1 is reproduced as follows:

1. A method in a multi-media collaborative data processing system which includes a shared data collection simultaneously accessible by a plurality of users of said system and a network connecting a plurality of terminals for communication, wherein each terminal has a display system and a user input device, of graphically indicating the relative location of said plurality of users within said shared data collection, comprising the steps of:

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presenting a display window at a terminal associated with a first user;

displaying in association with said display window a movable control icon constrained to move along a line parallel to an edge of said display window;

presenting within said display window a portion of said shared data collection, wherein said portion of said shared data collection is selected in response to a position of said movable control icon along said line; and

displaying a visual location cue along said line, said visual location cue indicative of a relative location of a corresponding portion of said shared data collection displayed at a terminal associated with a second user.

The examiner relies on the following references:

Bates et al. (Bates)	5,337,407	Aug. 9, 1994
		(filed Dec. 31, 1991)

Cowart, Robert, Mastering Windows™ 3.0, Copyright 1990 by Sybex Inc., pages 18-21.

Claims 1-17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Bates in view of Cowart.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

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We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-17. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following two groups: Group I has claims 1-4 and 10-13, and Group II has claims 5-9 and 14-17. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986);

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In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claims 1 and 5 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS

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Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to representative, independent claim 1, the examiner notes that Bates teaches the two "presenting" steps. The examiner acknowledges that Bates does not teach the two "displaying" steps of claim 1, but the examiner points to the scroll bar and elevator of Cowart as teaching these steps. The examiner concludes that it would have been obvious to combine Cowart's scroll bar and elevator with Bates' collaborative display [answer, pages 3-4].

Appellants argue that there is no teaching or suggestion in Bates and/or Cowart for providing a visual location cue along a line parallel to an edge of the window that indicates a relative location of a corresponding portion of the shared data object displayed at a terminal associated with a second user. In appellants' view, Cowart might suggest adding a scroll bar elevator to the window display of Bates,

but there is no suggestion to present a second such visual cue which corresponds to a second user along the edge of the window [brief, pages 4-6]. Appellants assert that the examiner's bare allegation of obviousness does not satisfy the burden of presenting a prima facie case of obviousness.

The examiner responds that since Bates teaches the display of cursors for more than one user, and since the elevator on the scroll bar of Cowart is also used to indicate the location of a cursor within an active window, it would have been obvious to the artisan to add multiple scroll bars and/or elevators in Bates to correspond to the plural cursors shown therein. The examiner's rationale seems to be based on the fact that the information displayed in Bates' Figure 3 is relatively close together for the plurality of users [answer, pages 11-12].

After a careful review of the record in this case, we are constrained to agree with appellants that the examiner's conclusion of obviousness is not supported by the types of factual findings necessary to reach this conclusion. Our reading of the examiner's reasons for obviousness causes us to conclude that the examiner believes the claimed invention

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would have been obvious simply because it seems that it would have been obvious. Although we agree with the examiner that a window scroll bar and elevator for a single user would clearly have been suggested by the applied references, we fail to see how the addition of scroll bars and/or elevators for additional users is suggested by the applied references.

We note that Bates' Figure 3 shows a window having no scroll bar in which all the users' cursors are located within that single window. We could easily conceive of a situation where the text is larger than a single window and would, therefore, necessitate the standard Windows scroll bar and elevator in order to view the entire document. In such a situation, we can also conceive the likelihood that not all users will be located at the same portion of the document so that the Bates' cursors may not all be visible at the same time. Whether the size of the document and consequent loss of other users' on- screen cursors would have suggested the solution of displaying a visual location cue associated with a second user as recited in claim 1 is a question which has not been addressed by the examiner or appellants on this record. We decline to answer this important question in the absence of



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a record upon which the persuasiveness of competing arguments can be evaluated.

In summary, we find the present record insufficient to support the examiner's conclusion of obviousness with respect to independent claim 1. Therefore, we do not sustain the rejection of claims 1-4 and 10-13 under 35 U.S.C. § 103.

With respect to representative, independent claim 5, the examiner rejects this claim in a manner similar to the rejection of claim 1. Claim 5 differs from claim 1 in that the displayed visual location cue indicates a prohibited area of the document as opposed to the location of a second user. Appellants argue that the displaying of a visual location cue as recited in claim 5 is not suggested by the collective teachings of Bates and Cowart for the same reasons discussed above with respect to claim 1. We agree with appellants' arguments for essentially the same reasons discussed above in our consideration of claim 1. Therefore, we also do not sustain the rejection of claims 5-9 and 14-17 under 35 U.S.C. § 103.

In conclusion, we have not sustained the examiner's rejection of claims 1-17 under 35 U.S.C. § 103. Accordingly,

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the decision of the examiner rejecting claims 1-17 is  
reversed.

REVERSED

John C. Martin	)	)
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Jerry Smith	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Joseph Dixon	)	
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